

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Docket No.: P26995

C. L. BATES, *et al.*

Confirmation No.: 7213

Serial No.: 09/827,233

Group Art Unit: No. 2143

Filed: April 5, 2001

Examiner: D. E. England

For: **METHOD AND COMPUTER PROGRAM PRODUCT FOR PROVIDING  
EMAIL THAT GUIDES A RECIPIENT THROUGH A SET OF  
ASSOCIATED WEB PAGES**

**REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop **Appeal Brief - Patents**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314  
Sir:

This Reply Brief is in response to the Examiner's Answer dated October 19, 2007,  
the period for reply extending until December 19, 2007.

The Examiner maintains the grounds of rejection advanced in the final rejection of  
claims 1-20, and provides arguments in support thereof.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is  
directed to the arguments presented in the Examiner's Answer, and therefore must be  
entered unless the final rejection is withdrawn in response to the instant Reply Brief.

With regard to this Reply Brief, Appellant notes it is addressing points made in the  
Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

**POINTS OF ARGUMENT****First Issue**

On pages 3 and 12-13 of the Examiner's Answer, the Examiner reiterates the Section 112, 2<sup>nd</sup> paragraph, rejection relating to the "preferred viewing order" recited in claims 1-3, 8-11 and 16 which was set forth in the Final Office Action, but which Appellant did not address in the Appeal Brief.

Appellant submits that the Examiner has acted improperly. As the Examiner should well know, this rejection was specifically withdrawn in the Advisory Action of May 3, 2007. Appellant directs the Board's attention to box 5 of the form PTOL-303 attached to the Advisory Action of May 3, 2007, which clearly indicates that this rejection has been overcome.

Appellant believes that it properly relied upon the Advisory Action by not addressing this rejection in the Appeal Brief. To the extent that the Examiner wishes to maintain or reinstate this rejection, the Examiner should do so in a new Office Action in order to provide Appellant with a full and fair opportunity to address this matter.

**Second Issue**

On pages 11-12 of the Examiner's Answer, the Examiner responds to Appellant's arguments regarding the Section 112, 2<sup>nd</sup> paragraph rejection of claim 2 by again asserting that the association and/or relationship between the web page and the email are not set forth in the claim.

Appellant disagrees that this is a proper basis for rejecting claim 2 as indefinite.

Claim 2 recites, among other things, receiving an email and receiving a web page navigation associated with the email. Appellant submits that one having ordinary skill in the art, having read the specification, would have no difficulty understanding what is claimed.

35 U.S.C. § 112, 2<sup>nd</sup> paragraph, does not require that each recited feature of a claim have an association or relationship to another recited feature. Nor does Section 112, 2<sup>nd</sup> paragraph require the claims to recite how something is associated. The specification provides this function (see, e.g., step 215 of Fig. 2 and paragraph [0021] of the instant published application 2002/0147779), i.e., associating the navigation with the email. Appellant also submits that the Examiner has not cited any basis in patent law to support the Examiner's assertion of indefiniteness.

Finally, Appellant directs the Examiner's attention to the non-precedential decision *Ex parte PILCHOWSKI* attached hereto, and specifically to pages 3-5 of this decision which rejects the Examiner's understanding of a proper Section 112, 2<sup>nd</sup> paragraph, rejection.

### **Third Issue**

On page 15 of the Examiner's Answer, the Examiner explains that he "would like to withdraw the rejection since it isn't a clear 112, 2<sup>nd</sup> rejection, just a broad limitation." Appellant is at a loss to understand what the Examiner means. The Examiner has specifically indicated in the Examiner's Answer that the Section 112, 2<sup>nd</sup> paragraph, rejection of claim 2 stands and explained why this rejection is improper. However, the Examiner has also concluded on page 15 of the Examiner's Answer that he would nevertheless "like to

withdraw the rejection”.

Appellant respectfully requests clarification on this matter. Is the Examiner withdrawing or maintaining the Section 112, 2<sup>nd</sup> paragraph, rejection of claim 2?

#### **Fourth Issue**

On pages 15-17 of the Examiner’s Answer, the Examiner maintains that CARTER does teach the sending of an email that includes a preferred viewing order of the HTML documents as broadly interpreted at least because Appellant has not defined or stated what a preferred viewing order is or could be.

This argument is incorrect for two reasons. First, it ignores the claim language which specifically indicates that a web page navigation is generated in response to input of the originator and that the generated web page navigation includes plural uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient (claim 1). CARTER simply does not disclose the generating of a web page navigation that includes plural uniform resource locators and a preferred viewing order. Second, because Appellant has in fact described and/or defined the preferred viewing order in Appellant’s specification (page 7, lines 7-12 and page 9, line 12 to page 11, line 13 of the instant specification explain what is contemplated by the preferred viewing order), the Examiner cannot interpret this feature in a manner which is inconsistent with Appellant’s specification (see page 9 of the non-precedential decision *Ex parte PILCHOWSKI* attached hereto).

**Fifth Issue**

On pages 15-17 of the Examiner's Answer, the Examiner essentially argues that attaching HTML documents to an email and sending the email with such HTML documents (as taught in CARTER) is the same as generating a web page navigation that includes plural uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient because the HTML documents are necessarily arranged in some viewing order.

Appellant disagrees for two reasons. First, because the invention (e.g., claim 1) provides for sending to the recipient an email and a navigation that includes uniform resource locators (URLs) and a preferred viewing order, the recipient is provided by the sender of the email with an indication of a preferred viewing order. That is, it will be apparent from the email which order to view the URLs. This is not the case in CARTER.

There is no way for the recipient to know from the email in CARTER which HTML documents to view in which order at least because there is no indication in the email itself whether the HTML documents are arranged in any order. While the Examiner apparently believes that a sender of the email naturally attaches the HTML in a viewing order, this is not necessarily the case and, more importantly, it is not evident to the recipient from the email that the HTML documents are in fact in a viewing order that is preferred by the sender or originator of the email. Second, the Examiner's argument ignores a clearly recited claim feature. Claim 1, for example, specifically recites that the navigation is associated with the email and that the email and the navigation are sent to the recipient.

Attaching HTML documents to an email and sending the email with such HTML documents (as taught in CARTER) is simply not the same as associating a navigation with the email and sending the email and the navigation to the recipient, at least because CARTER does not disclose that the HTML documents are a navigation, much less, one that includes uniform resource locators (URLs) and a preferred viewing order.

### **Sixth Issue**

On pages 17-18 of the Examiner's Answer, the Examiner argues that the assertion noted above in the "Fifth Issue" is correct because the claim language does not state "how the recipient is to view the attachments" ... "and how the navigation is used at the recipient's email."

This argument fails for the two reasons noted above in the "Fifth Issue". As noted above, claim 1 provides for sending to the recipient an email and a navigation that includes uniform resource locators (URLs) and a preferred viewing order, and the recipient is provided by the sender of the email with an indication of a preferred viewing order. In CARTER, the email is sent only with HTML documents, i.e., no navigation is sent, much less, one having URLs and a preferred viewing order. Because Appellant's invention (e.g., claim 1) specifically provides for sending to the recipient an email with a navigation that includes URLs and a preferred viewing order, the recipient is provided with the preferred viewing order. This is not the case in CARTER at least because the recipient does not receive with an email either a navigation or a preferred viewing order, much less, both. Thus, there is simply no way for the recipient in CARTER to know

from the email which HTML documents to view in which order at least because there is no indication in the email itself whether the HTML documents are arranged in any order.

While the Examiner apparently believes that a sender of the email naturally attaches the HTML in a viewing order, this is not necessarily the case and, more importantly, it is not evident or made apparent to the recipient from the email that the HTML documents are in fact in a viewing order that is preferred by the sender or originator of the email. Again, the Examiner's argument also ignores a clearly recited claim feature. Claim 1, for example, specifically recites that the navigation is associated with the email and that the email and the navigation are sent to the recipient. Attaching HTML documents to an email and sending the email with such HTML documents (as taught in CARTER) is simply not the same as associating a navigation with the email and sending the email and the navigation to the recipient, at least because CARTER does not disclose that the HTML documents are a navigation, much less, one that includes uniform resource locators (URLs) and a preferred viewing order.

### **Seventh Issue**

On pages 17-18 of the Examiner's Answer, the Examiner repeatedly argues that the preferred viewing order can be interpreted as "the order in which the web pages were attached" in CARTER.

This interpretation is improper because it broadens the interpretation of this claim feature beyond the scope of Appellant's specification and because it ignores the fact that the invention (e.g., claim 1) requires that the preferred viewing order be part of a

navigation that is associated with the email and sent with the email.

As explained above, Appellant has in fact described and/or defined the preferred viewing order in Appellant's specification (page 7, lines 7-12 and page 9, line 12 to page 11, line 13 of the instant specification explain what is contemplated by the preferred viewing order) such that the Examiner cannot interpret this term in a manner which is not consistent with Appellant's specification (see page 9 of the non-precedential decision *Ex parte PILCHOWSKI* attached hereto).

Furthermore, because CARTER does not disclose that the HTML documents attached to the email include a navigation, CARTER cannot possibly be read to disclose the email contains a navigation that includes uniform resource locators (URLs) and a preferred viewing order (claim 1).

### **Eight Issue**

Throughout the Examiner's Answer, the Examiner makes various assertions which appear to be based on an argument of inherency. Appellant submits that such assertions are not consistent with MPEP 2112, which specifically states, in part:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at



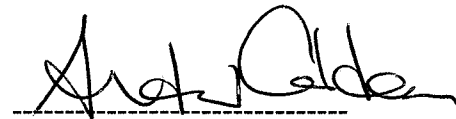
1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

The Examiner has provided no basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

### CONCLUSION

Accordingly, in view of the above-noted arguments (as well as those already of record), the Board is respectfully requested to reverse the Examiner's decision to finally reject claims 1-20 under 35 U.S.C. §§ 112, 102 and 103. Furthermore, the application should be remanded to the Examiner for withdrawal of the rejection over the applied documents and an early allowance of all claims on appeal should be provided. The Commissioner is hereby authorized to charge any fees necessary for consideration of this paper to deposit account No. 09-0457.

Respectfully submitted,  
C. L. BATES, *et al.*



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**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** THOMAS S. PILCHOWSKI

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Appeal No. 98-0584  
Application 08/238,948<sup>1</sup>

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ON BRIEF

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Before MEISTER, ABRAMS and CRAWFORD, **Administrative Patent Judges.**

MEISTER, **Administrative Patent Judge.**

**DECISION ON APPEAL**

Thomas S. Pilochowski (the appellant) appeals from the final rejection of claims 1-39, the only claims present in the application.<sup>2</sup>

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<sup>1</sup> Application for patent filed May 6, 1994.

<sup>2</sup> Claims 4 and 39 have been amended subsequent to final

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We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter new rejections of claims 4, 13, 17, 28 and 35 under 35 U.S.C. § 112, first and second paragraphs, and claims 1, 2, 6, 7, 32, 33 and 37 under 35 U.S.C. § 103.

The appellant's invention pertains to a power tool safety device for a power tool and to a power tool having such a safety device. Independent claims 1 and 32 are further illustrative of the appealed subject matter and copies thereof may be found in APPENDIX A of the brief.

The prior art relied on by the examiner is:

Lieber 1977	4,060,160	Nov. 29,
Hewitt 1993	5,181,447	Jan. 26,

Delta Instruction Manual, "10" Tilting Arbor Unisaw", Part No. 422-04-651-0024, ppg. 1-30 (Feb. 1990)

The claims on appeal stand rejected in the following manner.<sup>3</sup>

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rejection.

<sup>3</sup> Page 3 of the answer states that the final rejection of claim 39 under 35 U.S.C. § 112, first paragraph, is withdrawn.

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Claims 1-25, 27, 28 and 31-39 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 5-7, 14, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hewitt.

Claims 1-39 as being unpatentable over the Delta instruction manual in view of Hewitt and Lieber.

The rejections are explained on pages 2-9 of the Office action mailed on August 28, 1996 (Paper No. 11). The arguments of the appellant and examiner in support of their respective positions may be found on pages 8-23 of the brief, pages 3-12 of the reply brief and pages 4-26 of the answer.

#### **OPINION**

Considering first the rejection of claims 1-25, 27, 28 and 31-39 under 35 U.S.C. § 112, second paragraph, the examiner on pages 2-5 of Paper No. 11 and pages 3-6 of the answer sets forth a very lengthy list of recitations appearing in the claims which purportedly renders them indefinite. Having carefully reviewed each recitation identified in the

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lengthy list (including those not specifically mentioned below), we will not support the examiner's position.

The legal standard for indefiniteness is whether a claim **reasonably** appraises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed.

Cir. 1994). A degree of **reasonableness** is necessary. As the court stated in *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of § 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis added; footnote omitted.]

In other words, there is only one basic ground for rejecting a claim under the second paragraph of § 112 as being indefinite,

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namely, the language employed does not set out and circumscribe a particular area sought to be covered with a **reasonable** degree of precision and certainty when read in light of the specification.

Most of the examiner's criticisms are based on the view that the "structural relationships" or "structural cooperation" of various elements is unclear. For example, on page 3 of Paper No. 11 the examiner inquires "[w]here is the proximity detector in relation to the rest of the apparatus?" and questions whether "working surface" refers to the table or insert. Such criticisms, however, **all** go to the breadth of the structure set forth, and just because a claim is broad does not mean that it is indefinite. **See In re Johnson**, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); **In re Miller**, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); **In re Gardner**, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and **Ex parte Scherberich**, 201 USPQ 397, 398 (Bd. App. 1977). Apparently, the examiner has analyzed the various recitations that have been criticized

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in light of the appellants' disclosure and then decided what specific elements should be recited. Such an approach is improper. As explained by the court in *In re Steppan*, 394

F.2d 1013, 1019, 156 USPQ 143, 148 (CCPA 1967):

The problem, in essence, is thus one of determining who shall decide how best to state what the invention *is*. By statute, 35 U.S.C. 112, Congress has placed no limitations on *how* an applicant claims *his invention*, so long as the specification concludes with claims which particularly point out and distinctly claim that invention.

On page 5 of Paper No. 11, the examiner states that "coupled to respond" and "being connected to enable" are not positive statements of structural cooperation of the relevant elements. While such statements are functional in nature, we must point out that there is nothing wrong in describing the recited elements in

terms of the function that they perform. As the court in *In re*

*Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971)

stated:

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there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that "functional" language, in and of itself, renders a claim improper [under 35 U.S.C. 112, second paragraph].

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981): "It is well settled that there is nothing intrinsically wrong in defining something by what it does rather than what it is."

Pages 9 and 10 of the answer, the examiner questions how the magnetic field intensity detector<sup>4</sup> can be considered to detect "relative proximity." However, taking claim 3 as exemplary, it is set forth therein that the "proximity detector" includes at least one permanent magnet (e.g., magnet 126) and a magnetic field intensity detector (e.g., normally open reed switch 136). It is apparent from the disclosure that the permanent magnet and reed switch are movable relative to one another and, as explained on page 14 of the

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<sup>4</sup> Consistent with the specification, one of ordinary skill in the art would recognize that "magnetic field intensity detector" is used in the sense that a mechanism (i.e., a switch) is actuated in response to a predetermined magnetic field intensity, as distinguished from a detector which actually senses varying degrees of magnetic field intensity.



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specification, the nature of the reed switch and the strength of the magnetic field from the permanent magnet are such that the reed switch will be closed "when the permanent magnet is **approximately one inch away**" (emphasis added). This being the case, the magnetic field intensity detector (e.g., reed switch 136) can be fairly considered to "detect the predetermined relative proximity" as claimed.

We also observe that the examiner on page 8 of the answer states that

claim 1 does not set forth the limitation of a "proximity detector" in a manner that warrants coverage under 35 U.S.C. § 112, sixth paragraph.

We are at a complete loss to understand such a contention inasmuch as claim 1 has no limitation which is drafted in a means-plus-function format.

In view of the foregoing, we will not sustain the rejection of claims 1-25, 27, 28 and 31-39 under 35 U.S.C. § 112, second paragraph.

Turning to the rejection of claims 1, 5-7, 14, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hewitt, the examiner has taken the position that Hewitt's detector is a

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"proximity detector." In our view the examiner is attempting to expand the meaning of "proximity detector" beyond all reason. It is well settled that terms in a claim should be construed in a manner consistent with the specification and construed as those skilled in the art would construe them (*see In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). As we have noted above with respect to the § 112 rejection, the appellant on page 14 of the specification the appellant has described the nature of the proximity detector wherein the relative position of a permanent magnet and reed switch is such that the intensity of the magnetic field of permanent magnet is sufficient to move the reed switch from the open position to the closed position. In Hewitt, however, a locking rod 82 is secured to a pivotally mounted housing 28 which in turn indirectly supports a guard 8. The locking rod is provided with a dog 94 on one end thereof which actuates a **contact switch** (i.e., a tang 108 on a stationary micro switch 98) when

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the guard is in the lower or active position. Consistent with the appellant's specification, we can think of no circumstances under which the artisan would construe such structure to correspond to the claimed "proximity detector." Indeed, the reference to Lieber (which the examiner has relied on in the § 103 rejection) even teaches that the art recognizes the difference between a "contact switch" and a "proximity switch" (see column 4, line 23). Accordingly, we will not sustain the rejection of claims 1, 5-7, 14, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hewitt.

Considering now the rejection of claims 1-39 under 35 U.S.C. § 103 as being unpatentable over the Delta instruction manual in view of Hewitt and Lieber, the examiner considers that it would have been obvious to provide the saw of the Delta instruction manual with a safety device as taught by Hewitt in order to prevent undue harm to an operator. Additionally, the examiner is of the opinion that it would have been obvious to provide the modified saw with a proximity switch in lieu of the contact switch utilized Hewitt's safety device in view of the teachings of Lieber. We do not support

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the examiner's position. The Delta instruction manual teaches a table saw of the type having a splitter mounted directly behind the saw blade and a guard that is supported on the splitter by pivoted links in such a manner that the guard is movable toward and away from the surface of the saw table. Thus, Delta instruction manual teaches a table saw which (1) has a movably mounted guard that is supported on a splitter and which is of rather simple construction and (2) does not have a safety device which includes detector and interlock system. Hewitt, while teaching a table saw which has a movable guard and safety device that includes both a detector and interlock system, does so in the context of a relatively complicated mechanism for mounting the guard and the actuator for the safety device. That is, in Hewitt, rather than being supported on a splitter by pivoted links (Hewitt has no splitter whatsoever), the guard is suspended from a telescoping arm 16 that extends over the top of the table saw by a bracket 46, and this bracket is in turn attached to a pivotally mounted "superstructure" 28 in order that the guard may be pivoted from an active position over the saw blade and work supporting surface of the table saw to an inactive

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position away from the saw blade and work supporting surface. As we have noted above in the § 102 rejection, locking rod 82 is mounted on the pivotally mounted superstructure or housing 28 and is provided with a dog 94 on one end thereof for the purpose of actuating a contact switch (i.e., a tang 108 on a stationary micro switch 98) when the guard is in the lower or active position. Both the contact switch and interlock system 64 are mounted on the telescoping arm in a position adjacent the pivotally mounted housing 28 and, thus, the detector and interlock system are both remotely positioned from the guard and the work supporting surface of Hewitt's table saw. From our perspective, the examiner has improperly relied upon the appellant's own teachings for a suggestion to combine the teachings of the Delta instruction manual and Hewitt in the manner proposed. Lieber has only been relied on by the examiner for a teaching of a proximity switch. Accordingly, we will not sustain the rejection of claims 1-39 under 35 U.S.C. § 103 based on the combined teachings of the Delta instruction manual, Hewitt and Lieber.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections:

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Claims 4, 13, 17, 28 and 35 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon a non-enabling disclosure. Each of these claims set forth that "the magnetic intensity detector **generates** an electrical proximity signal indicating **whether or not** the guard is within the predetermined relative proximity to the working surface" (emphasis added). In the first place, the appellant has not disclosed any structure whatsoever that **generates a signal**. That is, in the appellant's device reed switches 136, 138 are merely closed thus allowing current to simply flow, as distinguished from "generating a signal." In the second place, even if the simple flow of current through the reed switches were considered to be "generating a signal," this "signal" or current flow does not take place when the guard is "not" within the predetermined relative proximity inasmuch as these reed switch are once again open.

Claims 4, 13, 17, 28 and 35 are rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the second paragraph of § 112, a claim must accurately define the invention in the technical sense. **See In re Knowlton**, 481

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F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Moreover, while the claim language of claims 4, 17, 28 and 35 may appear, for the most part, to be understandable when read in abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. **See In re Cohn**, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

Applying these principles to the present case, we fail to understand how magnetic field intensity detector (i.e., reed switches 136, 138) can be considered to "generate" an electrical proximity signal indicating "whether or not" the guard is within the predetermined relative proximity to the working surface for the reasons we have stated above in the rejection under the first paragraph of § 112. Thus, the language in these claim, when read in light of the specification, results in an inexplicable inconsistency that renders them indefinite.

Claims 1, 6, 7, 32, 37 and 38 are rejected under 35 U.S.C.

§ 103 as being unpatentable over Hewitt in view of Lieber. Hewitt discloses a power tool safety device for a power tool

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having a table 6 defining a working surface, a cutting tool 12 and a guard 8 wherein the safety device comprises a contact-type detector in the form of a tang 108 on a stationary micro switch 98 which detects the presence or absence of dog 24, an interlock system 80 which inherently includes a starting circuit and a bypass circuit 74, 78 having a bypass switch 74 (see Figs. 10 and 11). Although the detector of Hewitt is of the contact type, Lieber discloses a safety guard 12 and interlock system (Fig. 1) for a power tool 11 wherein, with respect to the detector 10, it is stated that this detector can be

a limit switch, contact switch, magnetic proximity switch, or any other arrangement of switches and sensors . . . . [Column 4, lines 22-24]

Accordingly, Lieber teaches that in the art of providing a safety guards and interlocks for power tools, contact switches and magnetic proximity switches are art-recognized alternatives and the artisan would have been well aware of the advantages and disadvantages of each. **See, e.g., In re Heinrich**, 268 F.2d 753, 756, 122 USPQ 388, 390 (CCPA 1959). In our view, the above-noted statement by Lieber would have



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provided an ample suggestion to one of ordinary skill in this art to substitute in Hewitt for his contact-type detector a magnetic proximity-type detector as taught by Lieber.

Claims 2 and 33 are rejected under 35 U.S.C. § 103 are rejected as being unpatentable over Hewitt in view of Lieber as applied in claims 1, 6, 7, 32, 37 and 38 above and in further view of the Delta instruction manual. Hewitt does not teach an insert for the blade aperture; however, the Delta instruction manual clearly teaches that the provision of an enlarged blade aperture and insert are well known expedients in the art of table saws (see, e.g., Fig. 46). In our view, one of ordinary skill in this art would have found it obvious to provide the table saw of Hewitt, as modified by Lieber, with an enlarged aperture and insert as taught by the Delta instruction manual in order to achieve the self-evident advantage of easy access to the saw blade.

In summary:

The examiner's rejections are all reversed.

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New rejections of claims 4, 13, 17, 28 and 35 under 35 U.S.C. § 112, first and second paragraphs, and claims 1, 2, 6, 7, 32, 33, 37 and 38 under 35 U.S.C. § 103 have been made.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

**REVERSED**  
**37 CFR § 1.196(b)**

	JAMES M. MEISTER	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	NEAL E. ABRAMS	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	MURRIEL E. CRAWFORD	)	
	Administrative Patent Judge	)	

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JMM/cam

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